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10/630,372	07/30/2003	Anil Kumar Goel	14618-009001	8958
26161 7590 11/27/2007 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER RIVIERE, HEIDI M	
			ART UNIT 3629	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/630,372	Applicant(s) GOEL, ANIL KUMAR	
	Examiner Heidi Riviere	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☒ Claim(s) 3 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. **Claims 3 and 20** are objected to because of the following informalities: use of the term "processes" instead of "possesses". Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1 and 18** are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The claims as written are missing key steps. Without these steps the meaning and definition of the limitation is lost and remains unclear. These claims state "determining if a user has access to a data source" however Examiner is unclear who or what makes this determination and what the data source is. These claims further disclose "identifying one or more upgrade package that would allow the user to access the data source". These claims as written fail to proclaim what happens when the package is identified. Therefore, the claims as described with missing steps make it difficult to operate invention.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1 and 18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims as written are missing key steps. Without these steps the meaning and definition of the limitation is lost and remains unclear. These claims state "determining if a user has access to a data source" however Examiner is unclear who or what makes this determination and what the data source is. These claims further disclose "identifying one or more upgrade package that would allow the user to access the data source". These claims as written fail to particularly point out or distinctly claim what happens when the package is identified.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-36** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gilliam et al. (US 7,206,765 B2)** (hereinafter "**Gilliam**") in view of **Marsh et al. (US 6,574,465 B2)** (hereinafter "**Marsh**").

8. **With respect to claims 1 and 18:** As best understood by Examiner, Gilliam teaches determining if a user has access to a data source; and in

response to the user being denied access to the data source. (Gilliam: Fig. 9; col. 5, lines 39-52; col. 6, lines 31-46; col. 41, line 60 – col. 4, lines 3 – digital rights management system can reference, call or locate item associated with rights offer; user can be denied use of item).

Gilliam does not teach identifying one or more upgrade packages that would allow the user to access the data source. However, Marsh teaches identifying one or more upgrade packages that would allow the user to access the data source. (Marsh: col. 8, lines 28-42; col. 9, lines 31-53; col. 17, lines 53-67; col. 18, Tables 6-7 - plan package options sorted by cost).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to deny access to a user and then identify one or more upgrade packages because of the motivation not to loose a client.

9. **With respect to claims 2 and 19:** Gilliam teaches maintaining a datastore that defines the authorizations possessed by one or more users. . (Gilliam: Fig. 9; col. 5, lines 39-52; col. 6, lines 31-46; col. 41, line 60 – col. 4, lines 3 – digital rights management system can reference, call or locate item associated with rights offer; user can be denied use of item).

10. **With respect to claims 3 and 20:** Gilliam teaches access to the data source is granted if a user processes a specific authorization. . (Gilliam: Fig. 9; col. 5, lines 39-52; col. 6, lines 31-46; col. 41, line 60 – col. 4, lines 3 – digital rights management system can reference, call or locate item associated with rights offer; user can be denied use of item).

11. **With respect to claims 4 and 21:** Gilliam teaches determining if a user has access includes: accessing a datastore record to obtain a list of authorizations possessed by the user. (Gilliam: Fig. 9; col. 5, lines 39-52; col. 6, lines 24-46; col. 41, line 60 – col. 4, lines 3 – digital rights management system can reference, call or locate item associated with rights offer; user can be denied use of item; users rights embodied in license).

12. **With respect to claims 5 and 22:** Gilliam teaches: comparing the list of authorizations possessed by the user to the specific authorization required to access the data source; wherein the user is denied access to the data source if the list of authorizations possessed by the user does not include the specific authorization required to access the data source. (Gilliam: Fig. 9; col. 5, lines 39-52; col. 6, lines 24-46; col. 30, lines 26-35; col. 41, line 60 – col. 4, lines 3 – digital rights management system can reference, call or locate item associated with rights offer; user can be denied use of item; users rights embodied in license; comparison module compares rights).

13. **With respect to claims 6 and 23:** Gilliam teaches maintaining a datastore that defines a plurality of data source packages, wherein each data source package includes one or more authorizations for data sources. (Gilliam: Fig. 9; col. 5, lines 39-52; col. 6, lines 24-46; col. 41, line 60 – col. 4, lines 3 – digital rights management system can reference, call or locate item associated with rights offer; user can be denied use of item; users rights embodied in license).

14. **With respect to claims 7 and 24:** Gilliam teaches the limitations cited above. However, Gilliam does not teach determining which of a plurality of data source packages includes a specific authorization required to access the data source, thus generating a list of upgrade packages. Marsh teaches determining which of a plurality of data source packages includes a specific authorization required to access the data source, thus generating a list of upgrade packages. (Marsh: col. 8, lines 28-42; col. 9, lines 31-53; col. 17, lines 53-67; col. 18, Tables 6-7 - plan package options sorted and listed by cost).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to include authorizations with data source and one or more upgrade packages because of the motivation not to loose a client.

15. **With respect to claims 8 and 25:** Gilliam teaches the limitations cited above. However, Gilliam does not teach the list of upgrade packages includes one or more discrete data source packages. Marsh teaches the list of upgrade packages includes one or more discrete data source packages. (Marsh: col. 8, lines 28-42; col. 9, lines 31-53; col. 17, lines 53-67; col. 18, Tables 6-7 - plan package options sorted and listed by cost).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to include data source packages with the upgrade packages because of the motivation not to loose a client.

16. **With respect to claims 9 and 26:** Gilliam teaches the limitations cited above. However, Gilliam does not teach the list of upgrade packages includes one or more premium data source packages. Marsh teaches the list of upgrade

packages includes one or more premium data source packages. (Marsh: col. 8, lines 28-42; col. 9, lines 31-53; col. 17, lines 53-67; col. 18, Tables 6-7 - plan package options sorted and listed by cost).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to include data source packages with the upgrade packages because of the motivation not to loose a client.

Furthermore, the data identifying types of data source packages is non-functional descriptive data.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Exemplary "functional descriptive material" consists of data structures and computer programs, which impart functionality when employed as a computer component. "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional

relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data identifying the selectable options and the information displayed upon selection of each option adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying types of data source packages does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

17. **With respect to claims 10 and 27:** Gilliam discloses the limitation cited above. However, while Gilliam does not teach determining an upgrade cost for each of the upgrade packages. However, Marsh discloses: determining an upgrade cost for each of the upgrade packages. (Marsh: col. 8, lines 28-42; col. 9, lines 31-53; col. 17, lines 53-67; col. 18, Tables 6-7 - plan options sorted by cost).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to determine the cost while ascertaining the upgrade package because of the motivation to "determine an optimal service plan" for subscribers. (Marsh: col. 1, lines 37-40).

18. **With respect to claims 11 and 28:** Gilliam discloses the limitation cited above. However, while Gilliam does not teach sorting the list of upgrade packages based on the upgrade cost associated with each of the upgrade packages. However, Marsh discloses: sorting the list of upgrade packages based on the upgrade cost associated with each of the upgrade packages. (Marsh: col. 8, lines 28-42; col. 9, lines 31-53; col. 17, lines 53-67; col. 18, Tables 6-7 - plan options sorted by cost).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to determine the cost while ascertaining the upgrade package because of the motivation to "determine an optimal service plan" for subscribers. (Marsh: col. 1, lines 37-40).

19. **With respect to claims 12 and 29:** Gilliam discloses the limitation cited above. However, while Gilliam does not teach sorting the list of upgrade

packages based on a profit margin associated with each of the upgrade packages. However, Marsh discloses: sorting the list of upgrade packages based on a profit margin associated with each of the upgrade packages. (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 18, Tables 6-7; col. 33, lines 8-19 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; chosen plan based on cost effective values; plan options sorted by cost).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to sort the packages based on profit margin while ascertaining the upgrade package because of the motivation to “determine an optimal service plan” for subscribers. (Marsh: col. 1, lines 37-40).

20. **With respect to claims 13 and 30:** Gilliam discloses the limitation cited above. However, while Gilliam does not teach sorting the list of upgrade packages based on a predetermined marketing preference. However, Marsh discloses: sorting the list of upgrade packages based on a predetermined marketing preference. (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 18, Tables 6-7 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; plan options sorted by cost).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to sort the list of packages based on a predetermined marketing preference while ascertaining the upgrade package because of the

motivation to "determine an optimal service plan" for subscribers. (Marsh: col. 1, lines 37-40).

21. **With respect to claims 14 and 31:** Gilliam discloses the limitation cited above. However, while Gilliam does not teach determining an undiscounted cost for an upgrade package; discounting the undiscounted cost based on a value associated with a list of authorizations possessed by the user. Marsh discloses:

- determining an undiscounted cost for an upgrade package; (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 18, Tables 6-7 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; chosen plan based on cost effective values; plan options sorted by cost) and
- discounting the undiscounted cost based on a value associated with a list of authorizations possessed by the user. (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 19, Table 8 and line 60 – col. 20, line 6 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; chosen plan based on cost effective values; plan options sorted by cost and also factors in discounts).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to determine the cost while ascertaining the upgrade package because of the motivation to "determine an optimal service plan" for subscribers. (Marsh: col. 1, lines 37-40).

22. **With respect to claims 15 and 32:** Gilliam discloses the limitation cited above. However, while Gilliam does not teach determining an undiscounted cost for an upgrade package; discounting the undiscounted cost based on a promotional discount. However, Marsh discloses:

- determining an undiscounted cost for an upgrade package; (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 18, Tables 6-7 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; chosen plan based on cost effective values; plan options sorted by cost) and
- discounting the undiscounted cost based on a promotional discount. (Marsh: col. 7, lines 30-39 – promotions taken into consideration when selecting optimal service plans).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to determine the cost while ascertaining the upgrade package because of the motivation to “determine an optimal service plan” for subscribers. (Marsh: col. 1, lines 37-40).

23. **With respect to claims 16 and 33:** Gilliam discloses the limitation cited above. However, while Gilliam does not teach determining an upgrade cost for each of the upgrade packages includes determining which of the upgrade packages requires one or more prerequisite data source packages. However, Marsh discloses determining an upgrade cost for each of the upgrade packages includes determining which of the upgrade packages requires one or more

prerequisite data source packages. (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 18, Tables 6-7 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; plan options sorted by cost).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to determine the cost while ascertaining the upgrade package because of the motivation to “determine an optimal service plan” for subscribers. (Marsh: col. 1, lines 37-40).

24. **With respect to claims 17 and 34:** Gilliam discloses the limitation cited above. However, while Gilliam does not teach determining an undiscounted cost for an upgrade package that requires one or more prerequisite data source packages; increasing the undiscounted cost based on a cost associated with the one or more prerequisite data source packages; discounting the undiscounted cost based on a value associated with a list of authorizations possessed by the user. Marsh discloses:

- determining an undiscounted cost for an upgrade package that requires one or more prerequisite data source packages; (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 18, Tables 6-7 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; chosen plan based on cost effective values; plan options sorted by cost).
- increasing the undiscounted cost based on a cost associated with the one or more prerequisite data source packages; (Marsh: col. 8,

- lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 19, Table 8 and line 60 – col. 20, line 6 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; chosen plan based on cost effective values; plan options sorted by cost and also factors in discounts) and
- discounting the undiscounted cost based on a value associated with a list of authorizations possessed by the user. (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 19, Table 8 and line 60 – col. 20, line 6 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; chosen plan based on cost effective values; plan options sorted by cost and also factors in discounts).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to determine the cost while ascertaining the upgrade package because of the motivation to “determine an optimal service plan” for subscribers. (Marsh: col. 1, lines 37-40).

25. **With respect to claim 35:** As best understood by Examiner Gilliam teaches determining if a user has access to a data source; and in response to the user not having access to the data source, (Gilliam: Fig. 9; col. 5, lines 39-52; col. 6, lines 31-46; col. 41, line 60 – col. 4, lines 3 – digital rights management system can reference, call or locate item associated with rights offer; user can be denied use of item).

Gilliam does not teach identifying one or more upgrade packages that would allow the user to access the data source. However, Marsh teaches identifying one or more upgrade packages that would allow the user to access the data source. (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col. 18, Tables 6-7 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; plan options sorted by cost).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to deny access to a user and then identify one or more upgrade packages because of the motivation not to loose a client.

26. **With respect to claim 36:** Marsh teaches a computer program product residing on a computer readable medium having a plurality of instructions stored thereon which, when executed by the processor, cause that processor to: determine if a user has access to a data source; and in response to the user not having access to the data source, (Gilliam: Fig. 9; col. 5, lines 39-52; col. 6, lines 31-46; col. 41, line 60 – col. 4, lines 3 – digital rights management system can reference, call or locate item associated with rights offer; user can be denied use of item).

Gilliam does not teach identifying one or more upgrade packages that would allow the user to access the data source. However, Marsh teaches identify one or more upgrade packages that would allow the user to access the data source. (Marsh: col. 8, lines 28-42; col. 9, lines 13-30; col. 17, lines 53-67; col.

18, Tables 6-7 – calling profile of customer assessed based on usage time of day, geographic location and type of calls made; plan options sorted by cost).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to deny access to a user and then identify one or more upgrade packages because of the motivation not to loose a client.

CONCLUSION

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heidi Riviere whose telephone number is 571-270-1831. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm EST.; Alternative Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Name: Heidi Riviere

Title: Examiner

Signature:



Date: 11/21/07

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